

REMARKS

This application was filed with 21 claims. Claims 1-21 have been rejected. Claims 1 and 16 have been amended. Therefore, Claims 1-21 are pending in the Application. Reconsideration of the application based on the remaining claims as amended and arguments submitted below is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-21 have been rejected under 35 U.S.C. § 103 as being unpatentable over Legrand (EPO 920,893) in view of Colvin, Jr. et al. (5,257,823).

As noted by the substantial authority covered in MPEP §2145, §2143.01, and the decisions of the Federal Circuit, it is improper to combine references without a teaching, motivation, or suggestion for combining the references. This teaching, motivation, or suggestion must be found in either the prior art or known generally by those skilled in the art. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01 (*citing In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) and *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)).

Also, as noted in MPEP §2142, §2143, and the decisions of the Federal Circuit, it is improper to use the present application as a means of suggestion for combining the prior art references. Further "[t]he level of skill in the art cannot be

relied upon to provide the suggestion to combine references." MPEP §2143.01 (*citing* Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161(Fed. Cir. 1999)).

Also," [t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03 (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03 (*citing In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

In regard to Claim 1, Claim 1, as amended to clarify the invention, includes features not disclosed in any of the cited prior art. Namely, the combined prior art does not disclose a flap board book comprising a first and second piece of grayback board with each piece including a flashing adapted to accept printing ink positioned only on a portion of the backsides. Neither Legrand nor Colvin mention grayback paperboard or a flashing on gray side of a grayback piece. Additionally, the Office Action states it would be obvious "to provide any desired board material for the book... on the basis of suitability for the intended use as a matter of design choice." Applicant would like to respectfully state that the use of grayback board material as conventionally known in the art is not suitable for the intended use of the invention. As specifically stated in the specifications in paragraph [004], as continued on page 2:

Grayback board is paperboard made with cheaper, non-bleached wood, or other fibers. Grayback board is usually coated only on one side which allows accurate and effective printing on that one coated side. However,

the uncoated side does not readily accept ink and cannot be printed upon due to the rough surface and gray color which obscures and masks the traditional four color printing process.

As such the use of grayback board, without more, is not as currently suitable "for the intended use as a matter of design choice".

Please note, Applicant has not invented the general flap board book and does not intend to claim as such. Instead, Applicant has invented a cost effective flap board book utilizing a cheaper form of paperboard – grayback paperboard – that includes a localized flashing used to prime the gray side of the grayback paperboard in order to be able to properly print on the gray side.

Claims 2-5 are dependent back to patentability distinct Claim 1 and includes features not disclosed in the prior art. As such, Claims 1-5 are patentable.

In regard to Claim 6, Claim 6 also includes features not disclosed in any of the cited prior art. As discussed above, none of the cite prior art discloses a page of a lift-the-flap board book comprising pieces of grayback board having a backside partially treated to accept printing ink and a rotateably attached flap cut to allow selective viewing of the partially treated backsides.

Claims 7-9 are dependent back to patentability distinct Claim 6 and includes features not disclosed in the prior art. As such, Claims 6-9 are patentable.

In regard to Claim 10, Claim 10 also includes features not disclosed in any of the cited prior art. As discussed above, none of the cite prior art discloses a flap board book comprising, among other features, grayback board having a portion of

Application No. 10/632,315
Response dated October 6, 2004
Reply to Office Communication of May 6, 2004

its backside exposed wherein only the exposed portion of the backside includes a treatment adapted to accept printing ink.

Claims 11-15 are dependent back to patentability distinct Claim 10 and includes features not disclosed in the prior art. As such, Claims 10-15 are patentable.

In regard to Claim 16, Claim 16 also includes features not disclosed in any of the cited prior art. As discussed above, none of the cite prior art discloses method of creating a page for a lift-the-flap book comprising, among other steps, providing a first piece of grayback board coated on a first side, flashing only a portion of a second side of the grayback board, and applying printed matter to the flashed portion of the second side.

Claims 17-21 are dependent back to patentability distinct Claim 16 and includes features not disclosed in the prior art. As such, Claims 16-21 are patentable.

Thus, Applicant respectfully requests that the rejection of Claims 1-21 under 35 U.S.C. §103 be withdrawn.

Applicant has commented on some of the distinctions between the cited references and the claims to facilitate a better understanding of the present invention. This discussion is not exhaustive of the facets of the invention, and Applicant hereby reserves the right to present additional distinctions as appropriate. Furthermore, while these remarks may employ shortened, more specific, or variant descriptions of

Application No. 10/632,315
Response dated October 6, 2004
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some of the claim language, Applicant respectfully notes that these remarks are not to be used to create implied limitations in the claims and only the actual wording of the claims should be considered against these references.

Pursuant to 37 C.F.R. § 1.136(a), Applicant petitions the Commissioner to extend the time for responding to the May 6, 2004, Office Action for 2 months from August 6, 2004, to October 6, 2004. Applicant encloses herewith a check in the amount of \$215 made payable to the Director of the USPTO for the petition fee. The Commissioner is authorized to charge any deficiency or credit any overpayment associated with the filing of this Response to Deposit Account 23-0035.

Respectfully submitted,



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